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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/841,184	04/24/2001	Walter Hamscher	11503-003001	3645
26161	7590	09/16/2004	EXAMINER	
FISH & RICHARDSON PC 225 FRANKLIN ST BOSTON, MA 02110			LESNIEWSKI, VICTOR D	
		ART UNIT	PAPER NUMBER	
		2155		

DATE MAILED: 09/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/841,184	HAMSCHER ET AL.	
	Examiner Victor Lesniewski	Art Unit 2155	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 24 April 2001.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-4 and 21-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-4 and 21-26 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) ✓	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date: _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____	6) <input type="checkbox"/> Other: _____

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-4 and 21-26 are drawn to a means for enabling collaborative processing of data using electronic mail messaging, classified in class 709, subclass 206.
 - II. Claims 5-20 are drawn to a means for electronic negotiation, classified in class 705, subclass 80.
 - III. Claim 27 is drawn to a means for remote data accessing via the Internet, classified in class 709, subclass 218.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I, II, and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, Invention I has separate utility such as using email to communicate in a computer conferencing environment. Invention II has separate utility such as modifying the text of a contract. Invention III has separate utility such as accessing data stored at a remote site. See MPEP § 806.05(d).
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with David Feigenbaum on September 9, 2004 a provisional election was made without traverse to prosecute the invention of group I, claims 1-4

and 21-26. Affirmation of this election must be made by applicant in replying to this Office action. Claims 5-20 and 27 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Tatham et al. (U.S. Patent Number 6,223,177), hereinafter referred to as Tatham.

8. Tatham has disclosed:

- <Claim 1>

A method comprising enabling a first party to a possible transaction to invoke an element of a user interface to cause electronic mail invitations to be sent to selected individuals

who will form a team representing the first party in connection with the transaction
(column 5, lines 9-14).

Since all the limitations of the invention as set forth in claim 1 were disclosed by Tatham, claim 1 is rejected.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 2-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tatham, as applied above, in view of Crawford et al. (U.S. Patent Number 6,502,113), hereinafter referred to as Crawford.

11. Tatham disclosed a network based groupware system with means to create a dedicated intranet site on a server. In an analogous art, Crawford disclosed an online negotiation manager for managing negotiations between parties. Just as Tatham's invention, Crawford's system allows collaboration between users who are a great distance away from each other by being implemented on an Internet website.

12. Although Tatham did not explicitly state that his system could be used by multiple groups (for example, a second party) in an electronic negotiation, Crawford's system focuses on online negotiation between parties. Furthermore, Tatham's system for a single collaborative group focuses on many of the same tools that are utilized by the multiple groups in the invention of

Crawford. Since the inventions encompass the same field of endeavor, it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the system provided by Tatham by adding the ability to support multiple groups in negotiation as provided by Crawford. This would make sense because it would allow more users to successfully utilize the tools of Tatham's system in conjunction with one another, which is a main purpose of a groupware system.

13. Thereby, the combination of Tatham and Crawford discloses:

- <Claim 2>

The method of claim 1 also including enabling the first party to invoke an element of a user interface to cause an electronic mail invitation to be sent to an administrator representing a second party to the transaction (Tatham, column 5, lines 9-14 and Crawford, column 7, lines 40-63).

- <Claim 3>

The method of claim 2 also including limiting permissions of the administrator with respect to interaction that will occur between the first party and the second party in connection with the transaction (Tatham, column 5, lines 44-54).

- <Claim 4>

The method of claim 2 also including enabling the administrator to invoke an element of a user interface to invite additional individuals to form a team representing the second party in connection with the transaction (Tatham, column 4, lines 55-60 and column 5, lines 1-14).

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Since the combination of Tatham and Crawford discloses all of the above limitations, claims 2-4 are rejected.

14. Claims 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hanson et al. (U.S. Patent Number 6,457,045), hereinafter referred to as Hanson, in view of Crawford.

15. Hanson disclosed a system for group choice making over a network. In an analogous art, Crawford disclosed an online negotiation manager for managing negotiations between parties. Just as Hanson's invention, Crawford's system is focused on collaboration among users over the Internet.

16. Although Hanson did not explicitly state that his system could be used by multiple groups in an electronic negotiation, Crawford's system focuses on online negotiation between parties. Furthermore, Hanson's system for a single collaborative group focuses on many of the same tools that are utilized by the multiple groups in the invention of Crawford. Since the inventions encompass the same field of endeavor, it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the system provided by Hanson by adding the ability to support multiple groups in negotiation as provided by Crawford. This would make sense because it would allow more users to successfully utilize the tools of Hanson's system in conjunction with one another, which is a main purpose of a groupware system.

17. Thereby, the combination of Hanson and Crawford discloses:

- <Claim 21>

A method comprising sending automatic electronic mail messages to parties engaged in an electronic negotiation of an agreement in connection with a transaction, the electronic

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mail messages providing notifications of state changes associated with the negotiation (Hanson, column 9, lines 31-39 and Crawford, column 2, lines 30-45).

- <Claim 22>

The method of claim 21 in which the state changes include changes to the agreement made since the electronic mail recipient's last viewing of the agreement (Hanson, column 13, lines 9-12).

- <Claim 23>

The method of claim 21 in which the state changes include the existence of new posted messages with respect to the negotiation (Hanson, column 13, lines 12-14).

Since the combination of Hanson and Crawford discloses all of the above limitations, claims 21-23 are rejected.

18. Claims 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Hanson and Crawford, as applied above, in view of Geiger et al. (U.S. Patent Number 6,073,142), hereinafter referred to as Geiger.

19. The combination of Hanson and Crawford disclosed a system for electronic negotiation and choice making that could be utilized by multiple groups of participants. In an analogous art, Geiger disclosed a system for controlling the distribution of email messages in a multi-user environment. Just as the combination of Hanson and Crawford, Geiger's invention allows for communication among users in a network via email.

20. Although the combination of Hanson and Crawford does not explicitly state the ability for a user to adjust his own email preferences, such as the volume of email he receives, Geiger's

system focuses on the rule analysis of email messages which allows users to control their email in different ways. Since the inventions encompass the same field of endeavor, it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the system provided by the combination of Hanson and Crawford by adding the ability for the user to control specific email preferences as provided by Geiger. This would make sense because it would allow for greater individual user control in the interaction of the group choice making or group negotiation.

21. Thereby, the combination of Hanson, Crawford, and Geiger discloses:

- <Claim 24>

The method of claim 21 also including enabling an individual associated with one of the parties to control the volume of the electronic messages sent to him (Geiger, column 3, lines 29-39).

- <Claim 25>

The method of claim 21 in which the volume of messages is controlled based on the type of state changes represented by the messages (Geiger, column 3, lines 39-52).

- <Claim 26>

The method of claim 25 in which the type includes changes in the composition of a team associated with one of the parties, changes in the text of the agreement, the posting of messages, or changes in an approval status of the agreement (Geiger, column 3, lines 39-52 and Hanson, column 13, lines 9-14).

Since the combination of Hanson, Crawford, and Geiger discloses all of the above limitations, claims 24-26 are rejected.

Conclusion

22. The prior art made of record and not relied upon is considered pertinent to the applicant's disclosure.

- Schaeffer et al. (U.S. Patent Number 5,446,842) disclosed a framework application over which multiple users can collaborate.
- Conklin et al. (U.S. Patent Number 6,141,653) disclosed a system for iterative negotiations over a network.
- Salas et al. (U.S. Patent Number 6,230,185) disclosed an apparatus for facilitating communication between collaborators in a networked environment.
- Yehuda et al. (U.S. Patent Number 6,266,683) disclosed a document management system for one or more participants.
- Quelene (U.S. Patent Number 6,453,306) disclosed a system for commercial transactions over a network.
- Bunney et al. (U.S. Patent Number 6,466,969) disclosed a system for sending and receiving notifications across a network.
- Shaffer et al. (U.S. Patent Number 6,490,614) disclosed a method for multimedia messaging collaboration and proposal approval.
- Tavor et al. (U.S. Patent Number 6,553,347) disclosed a method for conducting commercial negotiations over the Internet.
- Butler (U.S. Patent Number 6,584,493) disclosed a multiparty conferencing and collaboration system.

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- Borwankar (U.S. Patent Number 6,594,693) disclosed a system for a structured conversation using email.
- Chandhok et al. (U.S. Patent Number 6,662,212) disclosed a system for synchronizing files among a workgroup using email.
- Sheldon et al. (U.S. Patent Number 6,708,205) disclosed an email system with an interface to create directories for email.
- Hill, Ralph D.; and Brinck, Tom, "Groupware for Realtime Collaboration," Conference Companion on Human Factors in Computing Systems, ACM Press, April 1994, pgs. 369-370, disclosed an overview of groupware applications and implementations.
- Cohen, Andrew L.; Cash, Debra; and Muller, Michael J., "Designing to Support Adversarial Collaboration," Proceedings of the 2000 ACM Conference on Computer Supported Cooperative Work, ACM Press, December 2000, pgs. 31-39, disclosed a case study on collaborative document construction.

23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor Lesniewski whose telephone number currently is 703-308-6165, and beginning October 27 is 571-272-3987. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain Alam can be reached on 703-308-6662. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

VZ

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